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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIE-PASCALE LATORSE,
RICHARD MERCER, and THOMAS WEGMANN

Appeal 2011-003703
Application 10/553,363
Technology Center 1600

Before ERIC GRIMES, LORA M. GREEN, and STEPHEN WALSH,
Administrative Patent Judges.

WALSH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a fungicidal composition and method for its use. The Patent Examiner rejected certain claims as anticipated and the remainder as obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse the anticipation rejection but enter a new ground rejecting the same claims for obviousness, and we affirm the original obviousness rejection.

STATEMENT OF THE CASE

Claims 1, 15-17, and 21-23 are on appeal. Claims 1 and 21 are representative and read as follows:

1. A fungicidal composition comprising:
 - a) a pyridylmethylbenzamide derivative which is 2, 6-dichloro-N- {[3-chloro-5-(trifluoromethyl)-2- pyridinyl] methyl} benzamide also known as fluopicolide; and
 - b) a chloronitrile derivative which is chlorothalonil; in a fluopicolide/chlorothalonil weight ratio of from 1:20 to 1:1.
21. The fungicidal composition of claim 1 wherein the fluopicolide/chlorothalonil weight ratio is in the range of from 1/20 to 1/2, inclusive.

The Examiner rejected the claims as follows:

- claims 1 and 15-17 under 35 U.S.C. §102(e) as anticipated by Foor¹ and
- claims 21-23 under 35 U.S.C. § 103(a) as unpatentable over Foor.

ANTICIPATION

The Issue

The Examiner's position is that Foor taught a fungicidal composition comprising fluopicolide and chlorothalonil. (Ans. 3-4.) The Examiner also found that Foor taught a method of applying the composition to vegetable and fruit crops to control fungal growth. (Id. at 4.)

Appellants contend that Foor does not anticipate the instant claims because "[c]laims 1 and 15-17 all require that the weight ratio of

¹ Patent Application Publication No. WO 03/079788 A2 by Stephen Ray Foor, published Oct. 2, 2003.

fluopicolide/chlorothalonil be in the range of from 1:20 to 1:1,” but “[t]here is no mention of these currently claimed ratios in Foor et al.” (App. Br. 9.)

In response, the Examiner contends that Foor taught the combination fluopicolide and chlorothalonil and “[w]ithout any statement regarding ratios in Foor et al., this teaching reads on the claimed 1:1 ratio.” (Ans. 5.)

The issue with respect to this rejection is whether Foor disclosed a composition having a fluopicolide/chlorothalonil weight ratio of from 1:20 to 1:1.

Findings of Fact

1. It is undisputed that Foor taught a fungicidal combination of fluopicolide and chlorothalonil.
2. Foor disclosed ratio ranges, including a ratio of 1:1, for fungicidal compositions comprising compounds (a) and (b), where compound (a) was fluopicolide and compound (b) was selected from a group that did not include chlorothalonil. (See Foor pp. 37- 38, 50.)
3. Foor disclosed:

The weight ratios of component (b) to component (a) typically is from 100: 1 to 1: 1 00, preferably is from 30: 1 to 1 :30, and more preferably is from 10: 1 to 1: 10. Of note are compositions wherein the weight ratio of component (b) to component (a) is from 10: 1 to 1: 1. Included are compositions wherein the weight ratio of component (b) to component (a) is from 9:1 to 4.5:1.

(Id. at 38, ll. 5-9.)
4. Foor disclosed that its compositions comprise at least one carrier. (Id. at 44-45.)

Principles of Law

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Analysis

The Examiner did not make a finding regarding the ratio of fluopicolide and chlorothalonil in rejecting the claims. Thus, the rejection

did not account for each and every element set forth in the claimed invention, as required for an anticipation rejection. *Verdegaal Bros.*, 814 F.2d at 631. The requirement was not satisfied by the Examiner's responsive reasoning that "[w]ithout any statement regarding ratios in Foor et al., [the disclosure] reads on the claimed 1:1 ratio..." (Ans. 5) because it is not apparent on its face that Foor intended fluopicolide and chlorothalonil to be combined in equal amounts, or that its discussion of ratios applied to a combination of fluopicolide and chlorothalonil. Consequently, we reverse the anticipation rejection.

OBVIOUSNESS

A. Claims 1 and 15-17 are newly rejected under 35 U.S.C. § 103(a) as unpatentable over Foor. (37 C.F.R. § 41.50(b)). "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456 (1955).

Appellants acknowledged that Foor disclosed a fungicide composition comprising fluopicolide and chlorothalonil. (App. Br. 9.) Appellants also acknowledged that Foor "is replete with teachings of the ratios of" compound (a), including fluopicolide, to a compound (b), which did not include chlorothalonil. (*Id.*) These teachings included a ratio of 1:1. (FF-2.) While Foor did not expressly disclose a ratio for the combination of fluopicolide and chlorothalonil, we first find that the disclosed ratios for other combinations with fluopicolide suggested the same ratios for any of Foor's fungicide compositions. (See FF-3.) We conclude that it would have been obvious to a person of ordinary skill in the art at the time of the

invention to prepare and use a fungicidal composition comprising fluopicolide and chlorothalonil in a weight ratio of 1:1. We also conclude that the range of ratios from 1:20 to 1:1 would have been obvious because optimizing the ratio would have been within the level of ordinary skill in the art. See *In re Aller*, 220 F.2d at 456.

Dependent claim 15 recites “[t]he composition of claim 1 further comprising a member selected from the group consisting of an agriculturally acceptable support, a carrier, a filler, and a surfactant.” (App. Br. 13, Claims App’x.) Foor taught this further limitation by disclosing that its compositions comprise at least one carrier. (FF-4.)

Dependent claim 16 recites, “A method for combating and controlling phytopathogenic fungi of crops comprising applying an effective and non-phytotoxic amount of a composition according to claim 1 to seed, plant and/or to fruit of the plant or to soil in which the plant is growing or in which it is desired to grow.” (App. Br. 13, Claims App’x.) Dependent claim 17 further recites that “the plant is selected from the group consisting of potato, vegetables, and lawn.” (Id. at 14.) These claims would also have been obvious because Foor taught a method of applying its compositions to vegetable and fruit crops to control fungal growth. (See Ans. 4.)

B. The Examiner’s rejection of claims 21-23.

The Issue

The Examiner applied Foor as discussed regarding the anticipation rejection. (Ans. 4.) Further, the Examiner found that Foor taught “all that is recited in claims 21-23 except for fluopicolide to chlorothalonil in a ratio of from 1:20 to 1:2.” (Id.) According to the Examiner, Foor’s teaching the

combination of fluopicolide and chlorothalonil makes all ratios of these components obvious in the absence of unexpected results. (Id.)

Appellants contend that “they have discovered a combination that clearly exhibits synergism and is neither disclosed nor suggested by the cited art.” (App. Br. 10.) According to Appellants, the claimed combination of fungicides provides the unexpected result of “exhibit[ing] a synergistic effect that allows a reduction of the chemical substances spread into the environment and a reduction of the cost of the fungal treatment.” (Id.)

The issues with respect to this rejection are:

whether the record supports the Examiner’s conclusion that the cited references would have made the claimed composition and method *prima facie* obvious, and if so,

whether Appellants have provided evidence of unexpected results such that the totality of evidence weighs in favor of nonobviousness.

Additional Findings of Fact

5. Foor stated, “It is found that compositions containing the compound of Formula I [i.e., fluopicolide] and fungicides with a different mode of action exhibit synergistic effects.” (Foor at 49.)

Principles of Law

“[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.” *In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991).

“Only if the ‘results of optimizing a variable’ are ‘unexpectedly good’ can a

patent be obtained for the claimed critical range.” In re Geisler, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (quotations omitted).

“[B]y definition, any superior property must be unexpected to be considered as evidence of non-obviousness. Thus, in order to properly evaluate whether a superior property was unexpected, the [fact-finder] should . . . consider[] what properties were expected.” Pfizer, Inc. v. Apotex, Inc., 480 F.3d 1348, 1371 (Fed. Cir. 2007) (internal citations omitted).

Analysis

To the extent Appellants contend that “they have discovered a combination that . . . is neither disclosed nor suggested by the cited art” (App. Br. 10) we disagree. As discussed in the new ground of rejection *supra*, a skilled artisan would have found it obvious to optimize the weight ratio for fluopicolide/chlorothalonil to within the instantly recited range based upon Foor’s disclosure of the general ranges of components for its fungicide compositions.

We remain unpersuaded by Appellants’ assertion of unexpected results. According to Appellants, the instantly claimed combination of fungicides provides the unexpected result of “exhibit[ing] a synergistic effect that allows a reduction of the chemical substances spread into the environment and a reduction of the cost of the fungal treatment.” (App. Br. 10.) However, Foor disclosed that its compositions exhibited synergism. (FF-5.) Therefore, a skilled artisan would have expected a synergistic result from the combination. See e.g., In re Diamond, 360 F.2d 214, 217 (CCPA 1966) (affirming obviousness where the evidence showed that synergy was

expected because combined drugs targeted different cellular mechanisms, and no evidence to the contrary was produced). Because synergism was expected, that factor is not persuasive of nonobviousness. See, e.g., Pfizer, 480 F.3d at 1371.

We conclude that claims 21-23 would have been obvious over Foor. Although we affirm the rejection of these claims, our grounds and reasoning differ from the Examiner. Accordingly, we designate the affirmance a new ground of rejection under 37 C.F.R. § 41.50 (b).

CONCLUSIONS OF LAW

Foor did not disclose the claimed fungicidal compositions and methods of claims 1 and 15-17.

The claimed fungicidal compositions and methods of claims 1 and 15-17 would have been obvious over Foor to a skilled artisan at the time of the invention.

The record supports the Examiner's conclusion that Foor's teachings would have made the claimed composition and method of claims 21-23 *prima facie* obvious. Appellants have not provided evidence of unexpected results such that the totality of evidence weighs in favor of nonobviousness.

SUMMARY

We reverse the rejection of claims 1 and 15-17 under 35 U.S.C. §102(e) as anticipated by Foor; and

we affirm the rejection of claims 21-23 under 35 U.S.C. § 103(a) as unpatentable over Foor.

We enter a new ground of rejection under 35 U.S.C. § 103(a) over Foor for claims 1 and 15-17.

37 C.F.R. § 41.50(b)

This opinion contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner....
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record....

AFFIRMED; 37 C.F.R. § 41.50(b)

alw